

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** TED G. LAUTZENHEISER, THOMAS K. AUSTIN,  
and THOMAS R. PETERS

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Appeal No. 2000-2012  
Application No. 08/937,354

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ON BRIEF

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Before HAIRSTON, DIXON, and SAADAT, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-31,  
which are all of the claims pending in this application.

We AFFIRM-IN-PART.

Appellants' invention relates to a method and apparatus for using prior results when processing successive database requests. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for analyzing a data base, the method comprising the steps of:
  - a. accepting a first user request, wherein the first user request requires a first analysis of the database;
  - b. performing the first analysis of the database, and providing a first result;
  - c. storing the first result;
  - d. accepting a second user request, wherein the second user request requires a second analysis of the database; and
  - e. performing the second analysis of the database, the second analysis requiring the performance of the first analysis and a third analysis, said performing step 1(e) performing the third analysis and using the first result rather than performing the first analysis to provide a second result.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Abraham et al. (Abraham)	5,161,225	Nov. 3, 1992
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Claims 1-4, 14-23, 30, and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Abraham. Claims 5-13, and 24-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abraham.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed Feb. 15, 2000) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 14, filed Jan. 19, 2000) for appellants' arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellants have elected to group the claims as set forth in the brief at page 8. Therefore, we will select a representative claim from each group and address the examiner's rejection thereto.

### **35 U.S.C. § 102**

With respect to group one, we select independent claim 1 as the representative claim. Appellants argue that Abraham is directed to a system that reuses the same query repeatedly and the present invention saves partial and/or complete results from a request to be used as an input to the process of responding to a subsequent request.

Appellants argue that the subsequent request is different and the results are different. (See brief at pages 9-10.) Appellants provide an example from the specification to distinguish the claimed invention from that taught by Abraham. (See brief at pages 9 and 10.) As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). We find no limitations in independent claim 1 that define or limit the analysis to be different or the results to be different. Therefore, this argument is not persuasive. Appellants argue that element (e) requires that the second request is honored by dividing the second request into the first analysis and a third analysis, and the first analysis is utilized to obviate the need to again perform the first analysis. (See brief at page 11.) Appellants argue that there is "no division of the second analysis into the first analysis and a third analysis . . . there can be no combining of the results of this third analysis with the previously saved results of the first analysis." (See brief at page 12.) Appellants argue, therefore, that the rejection is clearly erroneous. We disagree with appellants and do not find support for appellants' arguments in the language of independent claim 1. Therefore, we will sustain the rejection of independent claim 1 and its dependent claims 2-4 which appellants elected to group therewith. Additionally, we note that there is no step of making a division or determination by a machine that a second analysis also requires the performance of the first analysis or that the results will be different from the results

of the first analysis. The breadth of the instant claims easily reads on the use of the same query or result set which has been saved in combination with an updating of the database at a later point in time. Here, the new (updated) data in the database is all that needs to be searched and combined with the prior results. We take OFFICIAL NOTICE that the USPTO APS search system from the 1980's and 1990's had the ability to save both line numbers from queries ("L" numbers) and search results sets ("S" numbers) that were repeatedly used by examiners to reduce lengthy database searches that were the same or similar and then to use them in combination with new search terms or in combination with other saved results sets. In the APS system the skilled patent examiner performed the determination of appropriateness of the searches and division of searches into smaller and reusable queries and results sets and combinations thereof. We find that this too would have been an anticipatory reference.

With respect to independent claims 14 and 15, appellants elected to group these claims with independent claim 1, but appellants have also provided brief arguments directed to these claims. (See brief at page 8.) Rather than merely group these claims with independent claim 1, we will address appellants' arguments. With respect to independent claim 14, appellants argue that the examiner has not addressed step (e) of claim 14 which determines whether the second analysis can be synthesized as a combination of the first result and third result. We agree with appellants and do not find that the examiner has identified a teaching of a determining step with respect to claim

14. Therefore, we will not sustain the rejection of independent claim 14 since the examiner has not established a ***prima facie*** case of anticipation.

With respect to independent claim 15, the examiner maintains that Abraham at col. 8, lines 5-33 and col. 11, lines 7-22 teaches the step of determining whether the second analysis can be synthesized as a combination of the first result and a third result. (See answer at page 5.) We disagree with the examiner and find that Abraham does not explicitly or inherently teach this determination step. While Abraham teaches the use of a sequential data set and queries with persistent stream and that the results of a query may be used more than once at col. 12, Abraham does not disclose what or how the results will be used in combination with any other data or subsequent queries such that a step of determining if the second analysis requires the performance of the first analysis.<sup>1</sup> Therefore, we will not sustain the rejection of independent claim 15 and its dependent claims 16-19 since the examiner has not established a ***prima facie*** case of anticipation.

With respect to independent claims 20, 30, and 31, appellants argue that the examiner has lost the distinction between method and apparatus claims and that the examiner has not applied Abraham against the claims. (See brief at page 14.) We

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<sup>1</sup> We note that we are not finding that a user may not perform this step, but only that Abraham does not teach that the system or a user performs a step of determining if the second analysis requires the performance of the first analysis.

disagree with appellants and find that the examiner has merely rejected the claims over the apparatus that is required to carry out the method disclosed by Abraham.

With respect to independent claim 20, we agree with the examiner's rejection and find that the apparatus of claim 20 does not require a "determination means" or a step of "determining" as discussed above with respect to independent claims 1, 14 and 15. We find that Abraham teaches an interface for accepting user requests, execution means for performing a first analysis, and storage means for storing the results. The execution means reads the results of the first request and performs a third request to provide the second results. Therefore, we will sustain the rejection of claim 20. Since appellants elected to group dependent claim 21 and independent claim 30 with independent claim 20, we will sustain the rejection of dependent claim 21 and independent claim 30 with independent claim 20.

Although appellants have elected to group claim 31 with claim 20 and rely on the argument that the examiner has not addressed these apparatus claims, we note that independent claim 31 parallels the limitations of claims 14 and 15 reciting a determining means. Since we found that Abraham did not teach a step of determining, it similarly does not teach a determining means, and we will not sustain the rejection of claim 31.

With respect to claims 22 and 23, the examiner maintains that the examiner has ignored the limitations of the knowledge module and inference engine and Abraham has no teaching of either the knowledge module or an inference engine. (See brief at page 15.) We agree with appellants, and find that the examiner has not shown where

Abraham teaches these claimed elements. Therefore, we will not sustain the rejection of claims 22 and 23.

### 35 U.S.C. § 103

To reject claims in an application under section 103, an examiner must show an unrebutted **prima facie** case of obviousness. **See *In re Deuel***, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper **prima facie** case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See *In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of **prima facie** obviousness or by rebutting the **prima facie** case with evidence of secondary indicia of nonobviousness. **See *id.***

***In re Rouffet***, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Here, we find that the examiner has set forth a statement of a rejection at pages 3-8 of the answer and has identified corresponding teachings in Abraham and identified the differences between the prior art and the claimed invention, and addressed these differences in the obviousness determination. Therefore, we find that the examiner has established a **prima facie** case of obviousness. Therefore, the burden shifts to appellants.

With respect to claim 5, appellants argue that the examiner has not appreciated the definition of “survey database” found in the specification at page 2, lines 19-20. (See brief at page 16.) We disagree with appellants and find that the specification states that a survey database is an example of a static database and that a survey



database “includes survey results that are obtained from a survey of, for example, selected customers.” Since the “selected customers” are not one of the requirements, the definition is as broad as “survey results that are obtained from a survey” which may be any type of data, either factual or opinion. Appellants argue that the examiner admits that the database of Abraham is not a survey database and is not static. (See brief at page 16.) With respect to the static nature of the data, appellants’ specification states that the data in the survey database remains static between updates or on a periodic basis between surveys. Therefore, we find that the database is not required to be static at all times. Therefore, appellants’ argument that the database of Abraham is not static since there is entry of data is not persuasive.

Appellants argue that the examiner does not distinguish between database types and the rejection is therefore in error. (See brief at pages 16-17.) We disagree with appellants and do not find that the limitation of “survey database” defines over the database of Abraham. Therefore, we will sustain the rejection of claim 5 and claims 6-9 which appellants elected to group with claim 5.

With respect to dependent claim 10, appellants argue that the examiner has not addressed the survey database with respect to an importance level and a satisfaction level. (See brief at page 17.) We agree with appellants and find that Abraham alone does not teach or suggest the limitations of dependent claim 10, and the examiner has not provided a convincing line of reasoning with respect to these limitations. Therefore, we will not sustain the rejection of claim 10 and its dependent claims 11-13.

With respect to dependent claims 24-29, appellants rely on prior arguments generally at page 18 of the brief. Since we found appellants' prior arguments unpersuasive with the exception of the determining step and the structure of the structure of the database, we do not find appellants' general argument persuasive, and we will sustain the rejection of claims 24-29.

### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-4, 20, 21 and 30 under 35 U.S.C. § 102 is affirmed and the decision of the examiner to reject claims 14-19, 22, 23 and 31 under 35 U.S.C. § 102 is reversed; the decision of the examiner to reject claims

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5-9 and 24-29 under 35 U.S.C. § 103 is affirmed; and the decision of the examiner to reject claims 10-13 under 35 U.S.C. § 103 is reversed. The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON  
Administrative Patent Judge

JOSEPH L. DIXON  
Administrative Patent Judge

MAHSHID D. SAADAT  
Administrative Patent Judge

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CHARLES A. JOHNSON  
UNISYS CORPORATION  
MS 4772  
2276 HIGHCREST ROAD  
ROSEVILLE, MN 55113